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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,725	01/13/2000	Marcus Peinado	MSFT-0092/127334.4	7394

7590 10/13/2004

Steven H Meyer
Woodcock Washburn Kurtz Mackiewicz & Norris LLP
One Liberty Place
46th Floor
Philadelphia, PA 19103

EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,725

Applicant(s)

PEINADO ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 280-299 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 280-299 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/31/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the communication filed on 5/25/2004.
2. Claims 106-299 were pending in this application; claims 280-299 are elected on 5/25/2004; and claims 106-279 are withdrawn.

Response to Amendment

3. The examiner submits that pending claims are fundamental and obvious to one of ordinary skill in the art at the time of invention with previous cited art of **Stefik** (US Pat. 5,715,403), Krishnan et al. (US Pat. 6,073,124), and Wyman (US Pat. 5,745,879 & 5,204,897). Since the pending claims were amended (not original claims), the examiner respectfully submits that because the applicants broader the pending claims' characteristics, no need for a combination of the above references.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

4. Claims 280, 283, 284, 288, 290, 291, 293, 294, 298 are rejected under 35 U.S.C. § 102(e) as being anticipate by **Krishnan et al.** (US Pat.6,073,124).

A. Re. to claims 280, 290: Krishnan et al. suggest steps for a server to provide to a client computer a digital license of right(s) to render digital content, the digital content encrypted with a decryption key, comprising:

- receiving a license request including a decryption key (see Krishnan et al., Fig.4 - ref. 402, Fig. 3 - refs. 31, and 310 - ELC, and Fig.9 box 909 shows an obvious task of decrypting the received ELC); then
- generating a license response including a digital rights license, the decryption key, and a certificate; and transmitting that response to the client (see Krishnan et al., Fig.19 refs. 1902-1903).

B. Re. to claims 281, 291: The rationales and reference for rejection of claim 280 are incorporated.

The examiner respectfully submits that a license request of Krishnan et al. inherently include answers for what, when, where, how about said request; i.e., a request of a content identifier, and a list of requested rights, and a server generates a license having those requested rights (see Krishnan et al., Fig.4 - ref. 402, Fig. 3 -

Serial Number: 09/482,725
Art Unit 3625

refs. 31, and 310 - ELC, and Fig.9 shows an obvious task of decrypting 909 the received ELC).

C. Re. to claims 283, 293: The rationales and reference for rejection of claim 280 are incorporated.

Krishnan et al. teach about transmitting a response to a client computer as part of an HTML page (see Krishnan et al., 3:24 to 4:9).

D. Re. to claims 284, 294: The rationales and reference for rejection of claim 280 are incorporated.

- Krishnan et al. teach of encrypting the license response; and encoding that response (see Krishnan et al., Fig.6, refs. 601-604).

8. Re. to claims 288, 298: Krishnan et al. teach that a request is contained in an HTTP request (see Krishnan et al., 3:45-61, 7:1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 282, 292 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan et al. (US Pat. 6,073,124).

A. Re. to claims 282, 292: The rationales and reference for rejection of claim 280 are incorporated.

The examiner respectfully submits that a license request of Krishnan et al. obviously includes a certificate associated with that client computer - in another word, a license is a rights to use a software at a specific computer.

6. Claims 285-287, 289, 295-297, 299 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan et al. (US Pat. 6,073,124), in view of in view of Stefik (US Pat. 5,715,403).

A. Re. to claims 285, 295: The rationales and reference for rejection of claim 280 are incorporated.

Krishnan et al. teach the license request includes a public key associated with the client computer; Krishnan et al. do not disclose about encrypting a decryption key.

However, Stefik suggests that idea of encrypting a decryption key with the public key to obtain an encrypted decryption key; "The requester decrypts the digital certificate using the public key of the master repository, recording the identity of the supplier and creator, a key for decrypting the software, the compatibility information, and a tamper-checking code. (This step authenticates the certification of the software, including the script for uninstalling it)", i.e., **Stefik** teaches that a public key

was used to decrypt a digital certificate/license, that public key is known by a requester.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a method for combining teachings in the disclosures of **Krishnan, & Stefik**, because this would increase an extra level of security protection by encrypting a decryption key.

B. Re. to claims 286, 296: the server certificate comprises a first certificate for validating the server. The examiner respectfully submits that on its face, a server certificate already defines a certificate for a server.

C. Re. to claims 287, 297: The rationales and reference for rejection of claim 280 are incorporated.

- It is obvious that a certificate may comprise a second certificate - it is merely containing an extra document.

D. Re. to claims 289, 299: The rationales and reference for rejection of claim 280 are incorporated.

It is obvious with Krishnan et al. that a request may include a version number for a Digital Rights Management (DRM) system on the client computer because this version number is merely a non-functional data descriptive material that does not have an inventive concept since including an extra information in a request only add extra non-functional data; this does not change the claimed step.

Conclusion

7. Applicants' amendment necessitated above new grounds of rejection presented in this Office action. Accordingly,

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number

Serial Number: 09/482,725
Art Unit 3625

for the organization where this application or proceeding is assigned is 703-305-7687/703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CHAN
CUONG H. NGUYEN
Primary Examiner
Art Unit 3625